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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.              | CONFIRMATION NO. |
|--|-------------|----------------------|----------------------------------|------------------|
| 09/992,902   | 11/14/2001  | Paul John Zuraw      | CHR 00-77                        | 5676             |
| 36876  | 7590        | 11/22/2005           | EXAMINER                         |                  |
| MEADWESTVACO CORPORATION<br>REGIONAL OFFICE BUILDING<br>PO BOX 118005<br>CHARLESTON, SC 29423-8005 |             |                      | PIAZZA CORCORAN, GLADYS JOSEFINA |                  |
|  |             |                      | ART UNIT                         | PAPER NUMBER     |
|  |             |                      | 1733                             |                  |

DATE MAILED: 11/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/992,902

Applicant(s)

ZURAW ET AL.

Examiner

Gladys JP Corcoran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**FINAL ACTION**

***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-7 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 1 newly recites, "the cellulosic-based paper substrate is a resin saturable paper not treated for sizing". While the Specification does disclose that the cellulosic-based paper is a saturating kraft paper and the Specification taken as a whole has support for the paper not being treated for sizing ([0015]), there is no support for a resin saturable paper. It is suggested to amend to --a saturating kraft paper not treated for sizing--.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

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the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 1-5, 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hagen (US Patent No. 3,215,579) in view of Bradner (US Patent No. 2,229,621).

Hagen discloses a method releasing laminates from one another in a heat and pressure consolidated press pack (column 1, lines 9-24) by arranging a plurality of thermosetting synthetic resin-impregnated fibrous core sheets in a superimposed relationship in groups of at least two stacks (column 2, lines 1-2, 26-53), separating the stacks from one another with a release sheet (column 2, lines 45-47) comprising a cellulosic based paper substrate (column 3, line 14) with a salt treatment of at least one surface of the substrate during formation of the substrate via the application to the surface of an aqueous solution comprising at least one water-soluble multivalent salt (column 3, lines 14-20, 52-57) in an amount sufficient to provide a solids content of about 0.01% to about 3% by weight based upon the dry weight of the substrate (column 3, lines 57-62) and the substrate is coated after formation on at least one salt-treated surface with a film comprising at least one salt of alginic acid (column 3, lines 65-70), consolidating the stacks of core sheets and release sheet by the application of heat and

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pressure and separating the resulting laminates from one another at the locus of the release sheet (column 2, lines 60-68).

Hagen discloses providing a sizing compound of a salt solution to the paper substrate (column 3, lines 51-62). It is unclear at what point of the formation of the paper substrate the sizing compound is applied, however it appears the sizing is applied once the paper substrate is in a web form. However, it is well known in the paper making arts to provide a sizing coating to a paper substrate while the paper substrate is still "on the forming machine" in order to reduce costs. For example, Bradner discloses a method of sizing a paper substrate with an aqueous coating composition where the sizing is applied "during the formation of the substrate" while the substrate is still "on machine" as an alternative to coating the sizing after formation of the substrate or "off-machine" in order to reduce time, labor and capital investment (column 1, lines 4-39). It is noted that one of the examples of sizing coatings that Bradner lists is a salt coating (calcium carbonate). It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the method of forming the releasing laminate as shown by Hagen by coating the water soluble salt sizing during the formation of the paper substrate as is well known in the art as a cost saving alternative to coating off-machine as exemplified by Bradner.

Applicant has newly amended the claim to include that the cellulosic-based paper substrate is a resin saturable paper not treated for sizing. The paper in Hagen is a standard saturating type kraft paper (column 4, lines 70-71), therefore the paper is considered to be a resin saturable paper. While Hagen discloses that the paper is sized

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with a salt treatment, this is the exact step that is eliminated by the obviousness statement above. As discussed above, it is well known in the paper making arts to provide a sizing coating to a paper substrate while the paper substrate is still "on the forming machine" in order to reduce costs as exemplified by Bradner. Therefore, one of ordinary skill in the art would be motivated to provide the salt treatment coating on-machine, which would result in a paper that is not treated for sizing.

As to claim 2, Hagen discloses that the salt is applied in an amount sufficient to provide a solids content of about 0.05% to about 1% by weight based upon the dry weight of the substrate (column 3, lines 57-61). As to claim 3, Hagen discloses that the salt is applied in an amount sufficient to provide a solids content of about 0.1% to about .5% by weight based upon the dry weight of the substrate (column 3, lines 57-61). As to claim 4, Hagen discloses all the salts as claimed (column 3, lines 37-51). As to claim 5, Hagen discloses all the salts as claimed (column 3, lines 37-51). As to claim 7, Hagen discloses all the alginic acid salts as claimed (column 4, lines 12-15).

6. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hagen in view of Bradner as applied to claim 1 above, and further in view of Malhotra et al. (US Patent No. 6,171,702) (optionally in view of Bauer ("Corrosivity of Calcium Salt Solutions" cited in the IDS filed December 6, 2004).

Hagen discloses that the water-soluble salt is selected from a wide variety of salts of common alkaline earth metals including salts derived from calcium (column 3, lines 37-51), however Hagen does not appear to specifically disclose calcium propionate as an example. However, it is well known in the art of coating paper

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substrates to use a variety of commercially available calcium salts including calcium propionate. It would have been well within the purview of one of ordinary skill in the art at the time of the invention to select a well known, commercially available salt for the method shown in Hagen. Furthermore, Malhotra discloses an example of a method of coating paper where the water soluble salt is a calcium propionate (column 4, lines 55-61). Bauer is optionally cited to further show that it was known in the art at the time of the invention to use a calcium propionate as an alternative to other calcium salts for coating paper webs in order to reduce the corrosivity of the machinery. It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the method of forming the releasing laminate as shown in Hagen and Bradner by selecting a well known, commercially available calcium salt of calcium propionate as would have been well within the purview of one of ordinary skill in the art and further exemplified as known in the art of coating paper as exemplified by Malhotra and optionally in order to reduce corrosivity of the equipment as exemplified by Bauer, only the expected results would be attained.

### ***Response to Arguments***

7. Applicant's arguments filed September 1, 2005 have been fully considered but they are not persuasive.

Applicant argues on page 6 that the application of the salt treatment in Hagen is by sizing a saturating-type kraft paper which is not "on-machine" during formation of the web and that the claimed invention is with no sizing. This does not address the obviousness statement presented above that it is well known in the coating arts to

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provide sizing treatments to paper "on-machine" in order to reduce costs by eliminated the later sizing step as exemplified by Bradner. Therefore one of ordinary skill in the art would be motivated to eliminate the sizing step by providing the salt treatment on-machine in order to reduce costs.

Applicant arguments on page 7 in reference to Jaisle are irrelevant in that that references is not relied upon for the above rejections.

### ***Conclusion***

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gladys JP Corcoran whose telephone number is (571)




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272-1214. The examiner can normally be reached on M-F 8am-5:30pm (alternate Fridays off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on (571) 272-1226. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Gladys JP Corcoran  
Primary Examiner  
Art Unit 1733

GJPC